

REMARKS

Claim 1 has been amended to incorporate the subject matter of Claim 5 and specify the moisture-curable, polyether urethane comprises 20 to 90% of component a) and 10 to 80% of component b). Accordingly, Claims 5-9 and 17-21 have been cancelled. No new matter has been added by the amendments.

Claims 1-4, 13-16 and 25 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,756,751 ("Schmalstieg, et al.") in view of U.S. Patent No. 5,068,304 ("Higuchi, et al.").

The Examiner indicates that Schmalstieg, et al. discloses a moisture-curable polyether urethane having at least two cyclic urea/reactive silane groups. The Examiner further notes that Schmalstieg, et al. is silent as to the degree of unsaturation of the polyether segments. However, the Examiner indicates Higuchi, et al. discloses the use of polyethers having a degree of unsaturation of not higher than 0.07 meq/g in a moisture-curable polyether urethane, and indicates that based on the disclosed advantages of a low degree of unsaturation, it would be obvious to use polyethers having such a low degree of unsaturation in the compositions of Schmalstieg, et al.

It is an axiom of patent law that in order to make out a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must consider every element of the pending claims. In this case, there has been no indication from the Examiner regarding the newly-added requirement in the present claims that the polyether urethane also comprise 10 to 80% of a polyether urethane containing one reactive silane group and one or more polyether segments having a number average molecular weight of 1000 to 15,000. Applicants note that both Schmalstieg, et al. and Higuchi, et al. are silent as to such a requirement. Further, the Examiner has provided no reason why such an element would be obvious to one of ordinary skill in the art, given the teachings of Schmalstieg, et al. As a result, withdrawal of the rejection is respectfully requested.


Claims 5-12 and 17-24 stand rejected under 35 U.S.C. § 103(a) as being obvious over Schmalstieg, et al. in view of Higuchi, et al., further in view of U.S. Patent Application Number 2003/0225237 ("Roesler, et al.").

Applicants direct the Examiner's attention to the amendment to the specification, claiming priority of the present application to December 20, 2002. As a result, Roesler, et al. could only be considered prior art under 35 U.S.C. §102(e). However, at the time the present invention was made, the Applicants were under an obligation to assign the invention to Bayer MaterialScience LLC, owner of Roesler, et al. As a result, the instantly claimed invention and of Roesler, et al. were subject to an obligation of assignment to the same person at the time the invention was made. Thus, under 35 U.S.C. §103(c)(1), Roesler, et al. cannot be considered as prior art for the present application.

Further, the Examiner acknowledges that Schmalstieg, et al. and Higuchi, et al. do not teach the polyether urethane b) required by the present claims. The Examiner has not indicated any motivation for including the polyether urethane. As such, the Examiner has failed to make out a *prima facie* case of obviousness under 35 U.S.C. §103(a), and withdrawal of the rejection is respectfully requested.

In view of the above amendments and remarks, reconsideration of the rejections and allowance of Claims 1-4, 10-16 and 22-25 are respectfully requested.

Respectfully submitted,

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